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HEWLETT PACKARD COMPANY		
P O BOX 272400, 3404 E. HARMONY ROAD		
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EXAMINER	
DUNHAM, JASON B	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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JERRY.SHORMA@HP.COM
mkraft@hp.com
ipa.mail@hp.com



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/698,849
Filing Date: October 31, 2003
Appellant(s): MORCINIEC ET AL.

Robert Popa
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/16/2007 appealing from the Office action mailed 10/10/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17 and 27 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v.

Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972);
Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 17 and 27 are non-statutory since they may be performed within the human mind.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al-
http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. The ground(s) for rejection are reproduced below from the final Office Action and are provided here for the convenience of both Appellant and The Board of Patent

Appeals:

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Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 17 and 27 are non-statutory since they may be performed within the human mind.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al- http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15, 17 and 19-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Hahn-Carlson (Patent Application Publication 2004/0010463 A1).

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Referring to claim 1. Hahn-Carlson discloses an apparatus for use in making a purchase decision regarding purchase of a plurality of units of a good or service at a particular purchasing time from a plurality of potential suppliers (Hahn-Carlson: at least claim 14, "...wherein the pricing engine is adapted to identify prices for a particular transaction between the buyer and a plurality of sellers and to inform the buyer of the prices."), the apparatus comprising

- Means for determining or otherwise obtaining a total quantity of units of said good or service required to be purchased at said purchasing time as defined by one or more purchase orders relating to said purchasing time (Hahn-Carlson: at least paragraph 0031, "The prices may be set, for example, using predetermined prices agreed to by the buyer and seller involved in the transaction. In another implementation, pricing arrangements such as quantity discounts, group discounts and conditional price variances are further automatically implemented in response to the transaction information and the approved contract details in the central transaction management arrangement."),
- Means for accessing details of terms under which said good or service may be purchased from each of said potential suppliers at said purchasing time (Hahn-Carlson: at least paragraph 0031), and
- Means for providing an indication of one or more consequences of allocating portions of said total quantity to be purchased among said plurality of potential suppliers (Hahn-Carlson: at least paragraph 0050, "The pricing rules may also

include, for example, prices associated with a particular quantity of products, with different per-product prices being assigned for particular quantities of products.").

The Examiner notes, claim 1 recites an apparatus for use in making a purchase decision regarding purchase of a plurality of units of a good or service at a particular purchasing time from a plurality of potential suppliers. This constitutes a statement of intended use, and does not limit the scope of the claim.

Referring to claim 2. Hahn-Carlson further discloses an apparatus wherein said terms are defined in contracts, with at least one contract being established in respect of each of said potential suppliers (Hahn-Carlson: at least paragraph 0062).

Referring to claim 3. Hahn-Carlson further discloses an apparatus including a contract repository in which details of each contract established in respect of said suppliers are stored (Hahn-Carlson: at least Fig. 2, "Collaborative Contracts Manager 210").

Referring to claim 4. Hahn-Carlson further discloses an apparatus wherein each contract is encoded prior to storage (Hahn-Carlson: at least paragraph 0057).

Referring to claim 5. Hahn-Carlson further discloses an apparatus wherein each contract is encoded as a record prior to storage, each record including one or more of a unique contract identifier, a start date and an end date of the contract, a good type, and a delivery location (Hahn-Carlson: at least claim 11, "...wherein the computer and communications node includes a pricing engine programmed to use business rules and transaction information to derive a pricing term for a transaction, the transaction

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information including at least one of: a contract identifier for the transaction, an item identifier for an item being sold, quantity and order date.”).

Referring to claim 6. Hahn-Carlson further discloses an apparatus wherein said terms are included in said encoded contract record (Hahn-Carlson: at least paragraph 0057).

Referring to claim 7. Hahn-Carlson further discloses an apparatus wherein said terms include a volume discount expressed as a discount function, defining a discount as a function of a quantity of said good or service (Hahn-Carlson: at least paragraph 0031, “The prices may be set, for example, using predetermined prices agreed to by the buyer and seller involved in the transaction. In another implementation, pricing arrangements such as quantity discounts, group discounts and conditional price variances are further automatically implemented in response to the transaction information and the approved contract details in the central transaction management arrangement.”).

Referring to claim 8. Hahn-Carlson further discloses an apparatus including means for storing details of said one or more purchase orders (Hahn-Carlson: at least Fig. 2).

Referring to claim 9. Hahn-Carlson further discloses an apparatus wherein the or each purchase order is encoded prior to storage thereof (Hahn-Carlson: at least paragraph 0057).

Referring to claim 10. Hahn-Carlson further discloses an apparatus wherein each purchase order is encoded in terms of one or more of an order due date, a good

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type, a quantity of the good specified in the purchase order, and a buyer location (Hahn-Carlson: at least claim 11, "...wherein the computer and communications node includes a pricing engine programmed to use business rules and transaction information to derive a pricing term for a transaction, the transaction information including at least one of: a contract identifier for the transaction, an item identifier for an item being sold, quantity and order date.").

Referring to claim 11. Hahn-Carlson further discloses an apparatus including a linking table for recording links between contracts and purchase orders (Hahn-Carlson: at least paragraph 0051).

Referring to claim 12. Hahn-Carlson further discloses an apparatus in which an aggregated quantity of goods or services purchased in respect of each contract is stored in said linking table (Hahn-Carlson: at least paragraph 0051).

Referring to claim 13. Hahn-Carlson further discloses an apparatus including a procurement decision interface which provides a visual indication of said consequences (Hahn-Carlson: at least paragraph 0041).

Referring to claim 14. Hahn-Carlson further discloses an apparatus wherein said procurement decision interface provides an indication of an average price per unit of a good required to be purchased, given that the total quantity of goods required at a specific purchasing time is allocated between a selected set of contracts in quantities prescribed by a user (Hahn-Carlson: at least paragraph 0041).

Referring to claim 15. Hahn-Carlson further discloses an apparatus including a data structure for storing a repository of demand schedules (Hahn-Carlson: at least

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paragraph 0063, "A variety of contract terms can be updated, such as contract eligibility, product availability, product price, price effective dates and tier eligibility.").

Referring to claim 17. The limitations of claim 17 closely parallel those of claim

1. Claim 17 is rejected under the same rationale as set forth above in claim 1.

The Examiner notes, claim 17 recites a method for use in making a purchase decision regarding purchase of a plurality of units of a good or service at a particular purchasing time from a plurality of potential suppliers. This constitutes a statement of intended use, and does not limit the scope of the claim.

Referring to claim 19. The limitations of claim 19 closely parallel those of claim 1 and 11-14. Claim 19 is rejected under the same rationale as set forth above in claim 1 and 11-14.

The Examiner notes, claim 19 recites an apparatus for use in making a purchase decision regarding purchase of a plurality of units of a good or service at a particular purchasing time from a plurality of potential suppliers. This constitutes a statement of intended use, and does not limit the scope of the claim.

Referring to claim 20. The limitations of claim 20 closely parallel those of claim 1. Claim 20 is rejected under the same rationale as set forth above in claim 1.

The Examiner notes, claim 20 recites an apparatus for use in making a purchase decision regarding purchase of a plurality of units of a good or service at a current purchasing time from a plurality of potential suppliers. This constitutes a statement of intended use, and does not limit the scope of the claim.

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Referring to claims 21-26. The limitations of claims 21-26 closely parallel those of claims 1-15. Claims 21-26 are rejected under the same rationale as set forth above in claims 1-15.

Referring to claim 27. The limitations of claim 27 closely parallel those of claim 1. Claim 27 is rejected under the same rationale as set forth above in claim 1.

The Examiner notes, claim 27 recites a method for use in making a purchase decision regarding purchase of a plurality of units of a good or service from a plurality of potential suppliers at each of a plurality of purchasing times within a predetermined period. This constitutes a statement of intended use, and does not limit the scope of the claim.

(10) Response to Argument

The Appellant argues (Brief, page 5) that Hahn discloses a system that is intended to be an interface between a buyer system and a seller system and to determine pricing for a contract based upon both the buyer's and the seller's criteria, and that Appellants' invention, on the other hand, is aimed at helping a buyer to allocate a purchase among a plurality of sellers.

The Examiner notes, in response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims merely recite providing an indication of one or more consequences of allocating portions of said total quantity to be purchased among said plurality of potential suppliers. The claims do not positively recite allocating the purchase.

However, Hahn discloses multiple instances that is aimed at helping a buyer to allocate a purchase among a plurality of sellers, for example:

- Hahn discloses a system wherein the pricing engine is adapted to identify transaction prices to a buyer for a selected transaction between the buyer and at least two sellers (Hahn: claim 12);

- Hahn discloses a system wherein a pricing engine is adapted to identify prices for a particular transaction between the buyer and a plurality of sellers and to inform the buyer of the prices (Hahn: claim 14); and
- Hahn discloses a system that is configured and arranged for cross-referencing different identification numbers from a plurality of sources, the different identification numbers corresponding to a single product (Hahn: claim 25).

It is clear, contrary to Appellant's argument, that Hahn is concerned with a purchasing decision regarding a purchase, wherein the purchases are spread between multiple suppliers.

By his remarks, the Appellant is attempting to interject extraneous meaning to the claim language that fall outside the scope of the claim's broadest reasonable interpretation. USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure, but limitations appearing in the specification but not recited in the claim should not be read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The

reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").

The Appellant argues (Brief, page 6) that the instant invention is aimed at providing the user with an understanding of how spreading a purchase order amongst several suppliers will impact the overall picture (e.g., total price) by allowing the user to vary the allocation among the suppliers and providing an indication to the user of the consequences (e.g. how the total price varies) of so varying the allocation.

The Examiner notes, in response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Appellant notes (Brief, page 6) that there is nothing in any of Appellants' submissions that is even vaguely reminiscent of an argument that Hahn suffers from a 112 shortcoming and Appellants are completely befuddled by the Examiner's statement.

The Examiner notes, in Appellant's response filed 9/11/2006, the Appellant raised an issue that Hahn is not a valid prior art reference for the present application. The response filed in the Advisory Action (12/27/2006) was in part responsive to said issue, whereby it was shown that Hahn (filing date May 12, 2003) properly claims priority to Provisional Application 60/379,561 filed on May 10, 2002.

The Appellant voices (Brief, page 7) his inability to ascertain the Examiner's position relating to the intended use recitation found in claim 27.

The Examiner notes, claim 27 recites, "A method for use in making a purchase decision regarding purchase of a plurality of units of a good or service from a plurality of potential suppliers at each of a plurality of purchasing times within a predetermined period."

The Examiner further notes, as clearly set forth in the MPEP, if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"); Kropa v. Robie, 187 F.2d at 152,

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88 USPQ2d at 480-81 (preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent in an old product defined by the remainder of the claim); STX LLC. v. Brine, 211 F.3d 588, 591, 54 USPQ2d 1347, 1350 (Fed. Cir. 2000) (holding that the preamble phrase “which provides improved playing and handling characteristics” in a claim drawn to a head for a lacrosse stick was not a claim limitation).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.


This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:


(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,



Jason Dunham
Examiner
AU3625


JEFFREY A. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

A Technology Center Director or designee must personally approve the
new ground(s) of rejection set forth in section (9) above by signing below:




Conferees:


Jeffrey A. Smith
SPE
AU3625

WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR

Vincent Millin
Appeals Conference Specialist
Technology Center 3600




Jason Dunham
AU 3625